

REMARKS

Reconsideration and allowance of the subject application are respectfully requested. By this Amendment, Applicant has canceled claims 2, 13 and 14. Thus, claims 1, 11 and 12 are now pending in the application. Applicant respectfully submits that the pending claims define patentable subject matter.

As set forth in the Office Action dated July 13, 2005, claims 1, 11 and 12 are rejected under 35 U.S.C. § 102(b) as being anticipated by Yusuke (JP 10-201146). Claims 1 and 11 are rejected under 35 U.S.C. § 102(b) as being anticipated by Yamada et al. (U.S. Patent No. 5,986,377; hereafter "Yamada"). Claim 1 is rejected under 35 U.S.C. § 102(e) as being anticipated by Fujita et al. (U.S. Patent No. 6,819,024; hereafter "Fujita"). Applicant respectfully traverses the prior art rejections.

By this Amendment, Applicant has amended independent claims 1 and 11 to recite "a cylindrical iron core including a plurality of concave portions provided around an outer circumferential face of the cylindrical iron core, ... wherein the welded portion lies between two adjacent concave portions of the plurality of concave portions." Support for the amendments to the claims can be found in FIGS. 3, 4 and 7 and page 14, lines 7-23 of the present application. Applicant respectfully submits that none of the cited references disclose these features of the amended claims.

Yusuke simply discloses that end faces (14a) of the back yoke (14) are fixed to each other with adhesive or welding (abstract). Similarly, Yamada simply discloses that the both end of the core are welded together (col. 6, lines 16-17) and Fujita simply discloses that both end portions

of the laminate core (15) are welded (col. 5, lines 57-59). Nowhere do Yusuke, Yamada and Fujita disclose that the core/yoke includes a plurality of concave portions provided around an outer circumferential face of the core/yoke and the welded portion lies between two adjacent concave portions.

Further, the cited references do not disclose that the cylindrical iron core has a lower radial crushing strength at the welded portion than at other portions of the cylindrical iron core, as required by claim 1, or the cylindrical iron core has a lower radial crushing strength at the notch portion than at other portions of the cylindrical iron core, as required by claim 11.

Although the Examiner asserts that that these features of the claims would be inherent in the stator cores of the cited references, Applicant respectfully submits that the Examiner's position is incorrect. If an element is inherently described by the prior art, "it must be necessarily present and a person of ordinary skill in the art would recognize its presence."¹ Inherency "may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."² Thus, in order for the stators of Yusuke, Yamada and Fujita to support an inherency basis for anticipation of the present invention, they must always and necessarily possess this structural property of the claimed cylindrical iron core. Applicant respectfully submits that Yusuke, Yamada and Fujita fail to meet this inherency standard.

¹ *Crown Operations International Ltd. v. Solutia Inc.*, 62 USPQ2d 1917, 1923, 289 F.3d 1367, 1377 (Fed. Cir. 2002).

² *Id.*

AMENDMENT UNDER 37 C.F.R. § 1.114(c)
U.S. Application No. 10/635,611

Accordingly, Applicant respectfully submits that claims 1 and 11, as well as dependent claim 12, would not have been anticipated by or rendered obvious in view of Yusuke, Yamada and Fujita because the cited references do not disclose all of the features of the claims.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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